

**REMARKS**

The following remarks are prepared in response to the Office Action of September 15, 2010. Applicant has amended independent claim 1 to include the features of dependent claim 5, and has canceled dependent claim 5. Applicant also added new claims 35-41, which do not contain any new matter. Claims 1-4, 6-20 and 35-41 are pending in this application, after entry of this amendment.

**Objection to the Specification**

The Examiner objected to the specification. Applicant has amended the specification accordingly and respectfully requests that the rejection be withdrawn.

**Claim Rejections — 35 U.S.C. § 102**

The Examiner rejected Claims 1 and 4-5 under 35 U.S.C. § 102(b) as being anticipated by *Garay et al.* (U.S. Pat. No. 4,925,446).

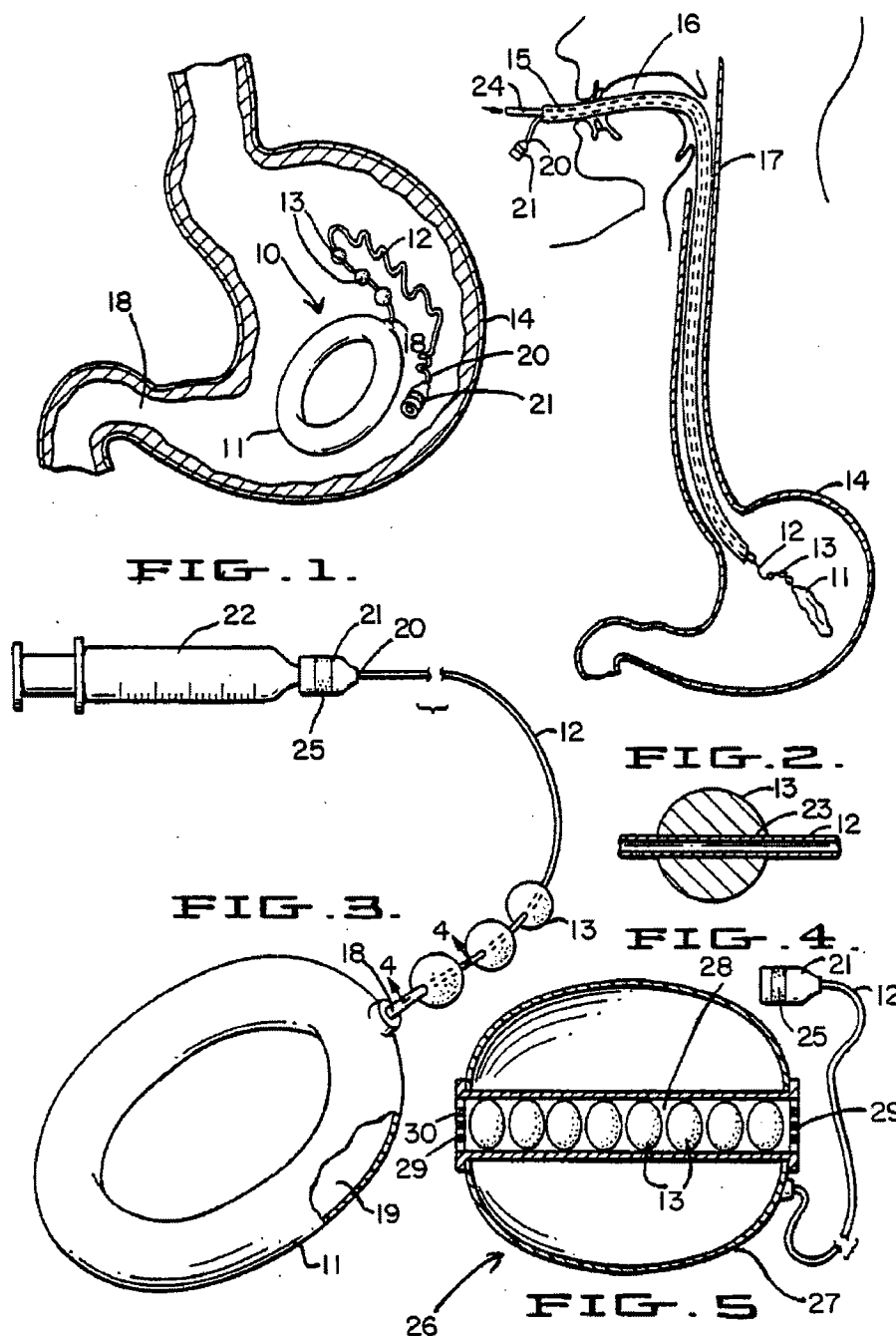
[T]he dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim [limitation] was disclosed in that single reference.

*Dayco Prods., Inc. v. Total Containment, Inc.*, F.3d 1358, 1368 (Fed. Cir. 2003).

**Independent Claim 1**

*Garay*, however, does not teach or suggest “a receiver having a recessed region in said shell” and “a retractable tubing housed in said receiver . . . wherein said shell is inflated and deflated from outside the body of the patient via said retractable tubing.”

As seen in FIGS. 1-5 reproduced below, the inflatable member 11 of the device 10 does not include a recess to house the tube 12. (Col. 3, lns. 58-61.)

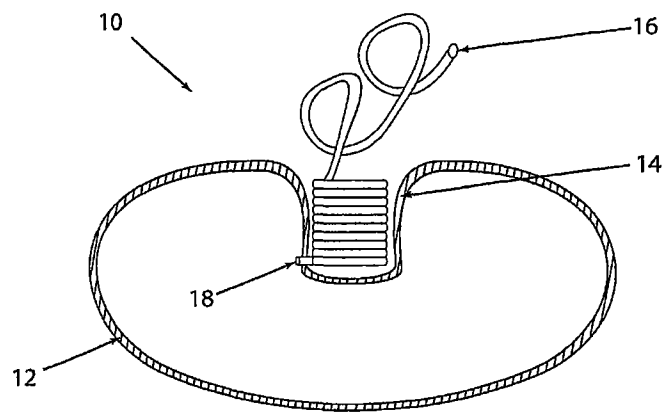


Instead, the tube 12 is left dangling outside of the inflatable member 11 in an unorganized manner. This can lead to the tube 12 being snagged, being wrapped around the inflatable member 11, or other problems. Thus, *Garay* does not disclose the features of the present invention, namely the “receiver having a recessed region in said shell” and the “retractable

tubing housed in said receiver . . . wherein said shell is inflated and deflated from outside the body of the patient via said retractable tubing.”

In contrast, in the present invention, the receiver 14 includes a recess to house the retractable tubing 16 as shown in FIG. 1 reproduced below. (Pg. 4, ln. 29 – Pg. 5, ln. 2.)

FIG. 1



This can allow for a greater organization of the retractable tubing 16, ensuring that it will not be accidentally wound over the shell 12 in an undesired manner. This allows the retractable tubing 16 to remain in the stomach, which is beneficial since the addition and removal of fluid will not require the insertion of a piercing or cutting instrument into the body. (Pg. 6, lns. 5 – 23.)

Furthermore, neither *Mouri et al.* (U.S. Pat. No. 6,074,378), *Gau et al.* (U.S. Pat. No. 5,084,061), *Adams* (U.S. Pat. Pub. No. 2002/0183765), *Trick* (U.S. Pat. No. 4,417,567), nor *Ekich* (U.S. Pat. No. 6,474,584) remedy the deficiencies of *Garay*. There is no indication that *Mouri*, *Gau*, *Adams*, *Trick*, or *Ekich* disclose that the receiver can include a recess.

Furthermore, *Cheng* (U.S. Pat. No. 4,693,695) also does not remedy the deficiencies of *Garay*. *Cheng* actually teaches away from *Garay*. *Cheng* is directed to a toy balloon action toy

which is filled with a lighter-than-air gas that repeatedly ascends and alternately descends on a tether. (Abstract.)

There is no indication that a children's toy can be ingested or implanted in a human being. In fact, toys are specifically designed so that they are not ingestible or implantable to prevent infants and children from choking. Indeed, it would be disturbing if such a toy were ingestible or implantable, as it could present a serious health hazard and would be unlikely to pass governmental regulations.

Furthermore, *Cheng* discloses that lighter-than-air gas such as helium should be used to fill the balloon portions 18, and 20. (Col. 3, lns. 49-53.) While *Garay* discloses that the inflatable member should not pass through the pyloric sphincter in its inflated state, there is no indication that it should be filled with lighter-than-air gas. (Col. 2, lns. 65-68.) Otherwise, if the inflatable member had lighter-than-air gas, it would float in air and reach the apex of the stomach. Such an apex would be the junction between the stomach and the esophagus. This could cause problems during food intake and/or cause potential ill feelings.

The *KSR* Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed."

In the same way, when the prior art teaches away from the claimed solution as presented here, obviousness cannot be proven merely by showing that a known composition could have been modified by routine experimentation or solely on the expectation of success; it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the known composition in a way that would result in the claimed composition.

*Ex parte Whalen et al.*, Appeal 2007-4423, slip op. at 16 (B.P.A.I. July 23, 2008) (citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)).

Thus, Applicant respectfully requests that the rejections of independent claim 1 and its dependent claims be withdrawn.

**Claim Rejections — 35 U.S.C. § 103**

The Examiner rejected claims 2-3 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Mouri*. The Examiner rejected claims 6-7 and 14 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Gau*. The Examiner rejected claims 1 and 8-9 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Cheng*. The Examiner rejected Claim 19 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Adams*. The Examiner rejected Claim 20 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Trick*. The Examiner rejected claims 15 and 17-18 under 35 U.S.C. § 103 as being obvious over *Garay* in view of *Cheng* and *Ekich*.

Independent Claim 1

The arguments regarding the patentability of independent claim 1 were discussed above with respect to the combination of the *Garay* and *Cheng* references. Thus, all arguments from above are repeated and incorporated herein.

Independent Claim 35

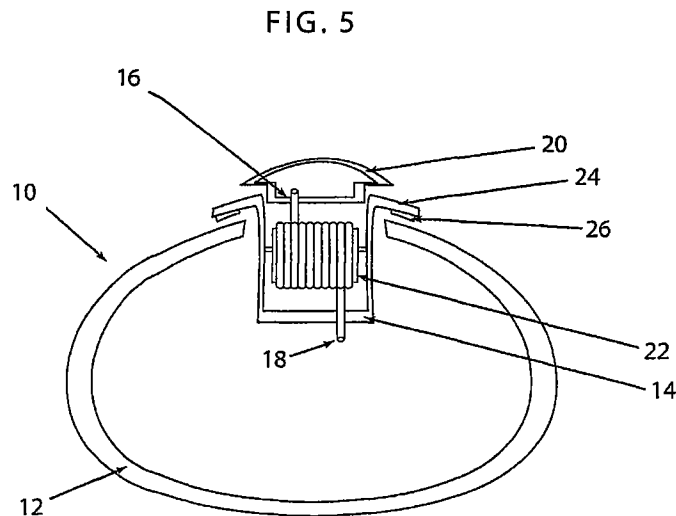
Independent claim 35 includes, for example, features of dependent claim 6.

Neither *Garay* nor *Gau* teach or suggest “a receiver having a molded valve patch coupled to the shell” and “a retractable tubing housed in said receiver . . . wherein said shell is inflated and deflated *in situ* from outside the body of the patient via said retractable tubing.”

The Examiner admits on Page 4 of the Office Action that *Garay* does not disclose the features of the present invention.

However, *Gau* does not remedy the deficiencies of *Garay*. The self healing valve 28 is not the receiver because it is the mechanism to inflate or deflate the intragastric balloon 20. (Col. 4, lns. 54-60.) Thus, it is not the receiver which houses the mechanism used to inflate or deflate the intragastric balloon 20. Furthermore, the valve cover patch 34 is not the receiver either because it does not house the self healing valve 28.

In contrast, in the present invention, as seen in FIG. 5 reproduced below, the molded valve patch 24 houses the retractable tubing 16.



Furthermore, there is no indication that *Cheng*, *Mouri*, *Adams*, *Trick*, or *Ekich* remedy the deficiencies of *Gau* or *Garay*.

Thus, independent claim 35 and its dependent claims are allowable.

#### Independent Claim 37

Independent claim 37 includes, for example, features of dependent claim 15.

Neither *Garay*, *Chen* nor *Ekich* teach or suggest “a torsionally loaded axle structured to retract said retractable tubing into said receiver.”

The Examiner admits on Page 6 of the Office Action that *Garay* and *Cheng* do not disclose the features of the present invention. Furthermore Applicant notes as discussed above, that *Cheng* teaches away from *Garay* and is non-analogous art.

However, *Ekich* also does not remedy the deficiencies of *Garay* and *Cheng*. *Ekich* also teaches away from *Garay*. *Ekich* is directed to a spring-loaded bobbin for use in tying fly fishing lures. (Abstract.)

Fly fishing lures are not ingestible for a human. Indeed, ingestion of fly fishing lures can cause severe damage to the human stomach and any accidental ingestion would certainly warrant a trip to the emergency room. The ingestion of sharp objects is generally undesirable.

*Ekich* also teaches away from the present invention. The spring-loaded bobbin 10 and spool 14 are used to tie knots to securely connect the fly to the thread 15. However, in the present invention, it is undesirable to have knots in the retractable tubing 16. If a knot were created in the retractable tubing 16, the retractable tubing 16 would be unable to fill the shell 12 with fluid.

Furthermore, there is no indication that *Mouri*, *Adams*, *Trick*, or *Gau* remedy the deficiencies of *Garay* or *Cheng*.

Thus, independent claim 37 and its dependent claims are allowable.

#### Independent Claim 41

Independent claim 41 includes, for example, features of dependent claim 8.

Neither *Garay* nor *Cheng* teach or suggest “a receiver dividing said shell substantially into two hemispheres.”

As previously noted, *Cheng* teaches away from *Garay*, and is non-analogous art. A children's toy should not be ingested or swallowed. Furthermore, there is no indication that *Mouri*, *Adams*, *Trick*, or *Gau* remedy the deficiencies of *Garay* or *Cheng*.

Thus, independent claim 41 is allowable.

Dependent Claims

Dependent claims 2-4, 6-20, 36, and 38-40 depend from and further define independent claims 1, 35, and 37, and are thus allowable, too.

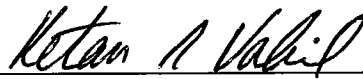
CONCLUSION

The application is deemed to be in condition for allowance and an expedited notice to this effect is respectfully requested.

If there are any questions with regards to this response, or if the Examiner believes that a telephone interview will help further prosecution of the application, the Examiner is invited to contact the undersigned at the listed telephone number.

Very truly yours,

**SNELL & WILMER L.L.P.**



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